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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/870,185 | 05/30/2001 | Clark Chen | INTL-0388-US (P8810) | 7287 |

7590 10/31/2003

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| EXAMINER |
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HARTMAN JR, RONALD D

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| ART UNIT | PAPER NUMBER |
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2127

DATE MAILED: 10/31/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/870,185

Applicant(s)

CHEN ET AL.

Examiner

Ronald D Hartman Jr.

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 May 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

1. Claims 1-15 are presented for examination.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1, 4, 7, 10-11 and 13 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Griffin et al, U.S Patent No. 6,489,950; having an effective filing date of 12/3/2002.

4. As per claim 1, Griffin teaches:

- providing a housing having a top and bottom sides (Figure 10);
- providing a display in the housing (Figure 9 element 4012); and
- a scroll wheel to control the display (Figure 9 element 4002), the scroll wheel extending through the top and bottom sides of the housing (Figure 11; wherein the solid line just above element 4006 represents the middle

of the device and the part above this line is the upper part of the device,
and the part below this line is the bottom part of the device).

5. As per claims 5-7, Griffin teaches:

- providing a housing having a top and bottom sides (Figure 10);
- providing a display in the housing (Figure 9 element 4012);
- enabling a scroll wheel (Figure 9 element 4002) to be manipulated between a user's thumb and forefinger, at the same time the housing is being held by the user's hand (claim 7; C19 L5-8).

6. As per claim 7, Griffin teaches the PDA type device may be used by the user using both either both hands of the user or by using only one hand of the user (claim 7; C18 L5-8).

7. As per claims 4, 10 and 13, Griffin teaches that the scroll wheel scrolls the display up and down (C6 L17-27 and C9 L60-63).

8. As per claim 11, Griffin teaches:

- a housing (Figure 10); and
- a scroll wheel (Figure 11 element 4002), extending from two sides of the housing (Figure 11; wherein the solid line just above element 4006 represents the middle of the device and the part above this line is the

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upper part of the device, and the part below this line is the bottom part of the device).

9. As per claims 5-6, Griffin teaches the device having a thumbwheel that is manipulate able by the thumb and forefinger of a user (claim 7; C18 L5-8).

Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 2-3, 8-9, 12 and 14-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Griffin et al., U.S. Patent No. 6,489,950; having an effective filing date of 12/3/2002, as applied to claims 1, 7 and 11 above.

12. As per claim 14, Griffin teaches:

- holding a tablet (Figure 9 and claim 7; C18 L5-8);
- manipulating a scroll wheel to scroll the display on the tablet between the user's thumb and forefinger (claim 7; C18 L5-8).

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13. As per claims 2, 8, 12 and 14-15, although Griffin does not specifically teach the PDA type device being used for Internet use or for explicitly using the web, they are features that are well known in the art, especially within the confines of PDA type devices. Therefore, since using a PDA for accessing the Internet is well known and since its incorporation would have been obvious since it would provide the PDA type device with a convenient way of checking email or other aspects of web browsing functions, this feature and its incorporation into Griffin would have been obvious to one of ordinary skill in the art at the time the invention was made.

14. As per claim 3, Griffin teaches the device being wirelessly accessible (C5 L59-63).

15. As per claim 9, although Griffin does not specifically teach the scroll wheel extending completely through the top housing and the bottom housing, it is a feature that would have been obvious to one of ordinary skill in the art at the time the invention was made. That is, since Griffin teaches that the cut-away portion of the top housing allows for easy control of the thumbwheel and that the thumbwheel is constructed in such a way that allows a user to use his/her thumb and forefinger to manipulate the wheel, a feature whereby the bottom portion of the housing is also cut-away, to expose the scroll user through the bottom of the device, is believed to be obvious over the design as disclosed by Figures 9-11. That is, since Griffin teaches that this cut-away aids the user in easily accessing the wheel, a cut-away portion on the bottom of the

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device would obviously aid the user in the same regards, the only difference being that the user can manipulate the device from the top or bottom. Therefore, since Griffin invention is contemplated to be used in one hand, and since this one handed operation would be made simpler by allowing the user to easily grasp and manipulate the wheel, a feature whereby the wheel is also accessible via the back of the device is a feature that would have been obvious to one of ordinary skill in the art at the time the invention was made since it would help the user to more easily and effectively control aspects of the display device.

Conclusion

16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ronald D. Hartman Jr. at (703) 308-7001. The examiner can normally be reached Mon. – Fri. 11:30 am – 8:30 pm, EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anil Khatri, can be reached at (703) 305-0282.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 305-9618.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks
Washington, D.C. 20231

Or faxed to:

(703) 872- 9306

Hand delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, VA., Sixth Floor (Receptionist).

Ronald D. Hartman Jr.
Patent Examiner
Art Unit 2121
October 22, 2003


ANIL KHATRI
SUPERVISORY PATENT EXAMINER